



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,718	07/05/2001	Stefanie Sprunck	514413-3886	4044
20999	7590	12/29/2003	[REDACTED]	EXAMINER
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SULLIVAN, DANIEL M	
[REDACTED]	[REDACTED]	[REDACTED]	ART UNIT	PAPER NUMBER
[REDACTED]	[REDACTED]	[REDACTED]	1636	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/899,718	SPRUNCK ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Daniel M Sullivan	1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)                  4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)                  5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                  6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is a reply to the "Amendment and Response to Office Action" of 22 September 2003 (hereinafter, 22 September Paper) filed in response to the Non-Final Office Action mailed 18 April 2003 (hereinafter, 18 April Office Action). Claims 1-18 were considered in the 18 April Office Action. Claims 2, 17 and 18 were canceled and claims 1, 13 and 14 were amended in the 22 September Paper. Claims 1 and 3-16 are pending and under consideration.

#### *Response to Amendment*

##### Claim Rejections - 35 USC § 112

Claims 1 and 3-16 stand rejected under 35 U.S.C. 112, first paragraph, as lacking adequate written description for the claimed subject matter for reasons of record and herein below in the "Response to Arguments".

Rejection of claims 14 and 16 under 35 U.S.C. § 112, first paragraph, as lacking enablement is withdrawn.

Rejection of claims 2, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn.

#### *Response to Arguments*

Claims 1 and 3-16 are rejected under 35 U.S.C. 112, first paragraph, as lacking adequate written description for the broad class of DNAs with caryopsis-specific promoter activity and having the indicated similarity to the disclosed sequence.

In response to the rejection of record, Applicant has amended the claims such that they are limited to having at least 90% identity with a nucleic acid that comprises the nucleic acid set forth as SEQ ID NO: 1, deposited by DSM 13398. Further, the claim encompasses nucleic acids that hybridize to nucleic acids comprising SEQ ID NO: 1 or fragments thereof and functional portions of a nucleic acid sequence comprising SEQ ID NO: 1 or deposited as DSM 13398. Because the claimed nucleic acids are identified as having some structural similarity to a nucleic acid defined using open language, there is essentially no structural limitation on the nucleic acid. For example, because the nucleic acid of part (a) can comprise SEQ ID NO: 1 and an infinite amount of undefined sequence, the nucleic acid of part (e) encompasses any nucleic acid molecule having 90% identity with SEQ ID NO: 1 or any of the undefined sequence also comprised by the nucleic acid molecule containing SEQ ID NO: 1.

Applicant argues that the facts in the instant case are analogous to those of Example 14 of the "Synopsis of Application of Written Description Guidelines". Applicant urges, "even if the claimed SEQ ID NO is the only species disclosed, it is representative of the genus because all members of the genus have the claimed level of identity with and function of the protein described by the reference sequence. Therefore, according to Example 14 of the Written Description Guidelines, claim 1, as presented herein, meets the written description requirement of 35 U.S.C. §112, first paragraph" (page 6). This argument has been fully considered but is not found persuasive. First, the facts of the instant claims are not analogous to the Example 14 at

least because all of the species of the genus in the Example were limited to having identity with the disclosed sequence. As described above, the instant claims embrace any nucleic acid that hybridizes with or has 90-99% identity with any nucleic acid comprising the disclosed sequence. Furthermore, even claims limited to having greater than 90% identity to SEQ ID NO: 1-8 embrace a broader genus than that of Example 14.

Therefore, for reasons of record and herein above, only the nucleic acids comprising SEQ ID NO: 1-8, comprising a functional portion of SEQ ID NO: 1, or comprising a nucleic acid that hybridizes with or has at least about 95-99% identity with a nucleic acid consisting of any one of SEQ ID NO: 1-8 and having the function of a caryopsis-specific promoter meets the written description guidelines.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448. The examiner can normally be reached on Monday through Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 703-305-1998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Please note: Art Unit 1636 will be moving to the new USPTO facilities on 14 January 2004. After that date, Examiner Sullivan can be reached at 571-272-0779 and Examiner Yucel can be reached at 571-272-0781.

DMS

*Anne-Marie Falk*  
ANNE-MARIE FALK, PH.D.  
PATENT EXAMINER